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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,626	01/15/2004	James R. Robellard	287.00070101	6109
26813 7590 02/13/2008 MUETING, RAASCH & GEBHARDT, P.A. P.O. BOX 581415 MINNEAPOLIS, MN 55458			EXAMINER CASTELLANO, STEPHEN J	
			ART UNIT 3781	PAPER NUMBER
			MAIL DATE 02/13/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	Application No. 10/758,626	Applicant(s) ROBELLARD ET AL.	
	Examiner /Stephen J. Castellano/	Art Unit 3781	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 10, 12-18, 21, 22, 26, 27, 29, 30, 32, 33, 36-38 and 40 is/are pending in the application.  
     4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 12-16, 18, 21, 22, 26, 27, 29, 30, 32, 33, 36-38 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11-30-07</u> . | 6) <input type="checkbox"/> Other: _____  |

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Claim 17 stands withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and specie, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 28, 2006.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30, 32, 38 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanssen.

Hanssen discloses a paint roller, frame and shield. When the shield is placed in a position to paint a ceiling, the shield defines an open top container body made of one-piece as the elongated handle can be removed. The container body has a sloped floor of arcuate shape and a pair of opposing sidewalls, the sloped floor and sidewalls define an elongated reservoir for holding liquid (paint). The roller includes an elongated cylinder having two circular end portions which attach the cylinder to the opposed sidewalls, the inside surface of the elongated cylinder has a first roller surface (a small longitudinal strip of the inside surface of cylinder) pivotally coupled to the container body in a first position (the position where the first surface lies closest to bolt 18), located within the reservoir at a level above the volume of liquid (which liquid is comparatively shallow in depth) and below the open top, and is further positioned about 70 degrees to about 110 degrees from vertical (the strip covers an arc of less than 40 degrees of the 360 degree inner circumference).

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Re claim 38, the first roller surface faces upward and the roller defines an access zone (another roller surface the extends outwardly and upwardly from the container body) that allows accessing liquid by a roller type applicator.

Note: Although claims 30 and 38 have been amended, applicant states on page 8, lines 19-21 of the remarks submitted November 30, 2007, "This amendment is intended to make explicit what was already implied, e.g., this amendment is not narrowing." Since the claims are no narrower than as previously submitted in the June 20, 2007 amendment, there is no reason to remove this rejection. Insofar as the claim has not been changed from the June 20, 2007 Office action, this rejection is maintained.

Re claim 40, the strip covers an arc of less than 20 degrees of the 360 degree inner circumference.

Claims 30, 32 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Dumesnil, Jr. (Dumesnil).

Dumesnil discloses a one-piece container body (paint tray) defining an open top reservoir for holding a designated volume of liquid and a first roller surface (part of the outer surface of the transfer roller positioned to face downwardly towards a surface of paint in the reservoir) pivotally coupled to the container body, the first roller surface is located within the reservoir at a level above the volume of liquid and below the open top and is further positioned about 70 to 110 degrees from the vertical (the portion of the outer surface is less than 40 degrees of the 360 degree inner circumference).

Note: Although claims 30 and 38 have been amended, applicant states on page 8, lines 19-21 of the remarks submitted November 30, 2007, "This amendment is intended to make

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explicit what was already implied, e.g., this amendment is not narrowing.” Since the claims are no narrower than as previously submitted in the June 20, 2007 amendment, there is no reason to remove this rejection. Insofar as the claim has not been changed from the June 20, 2007 Office action, this rejection is maintained.

If it should be deemed that the amendment does narrow the claim, this rejection is still maintained. Dumesnil’s first roller surface is fully capable of distributing liquid over a roller-type liquid applicator.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dumesnil in view of Bedrossian.

Dumesnil discloses the invention except for the lid. Bedrossian teaches a lid to cover a paint receptacle. It would have been obvious to cover the paint receptacle to keep contaminants from soiling paint in the tray or to preserve the freshness of the paint by keeping it from drying out.

Note: Although claims 30 and 38 have been amended, applicant states on page 8, lines 19-21 of the remarks submitted November 30, 2007, “This amendment is intended to make explicit what was already implied, e.g., this amendment is not narrowing.” Since the claims are no narrower than as previously submitted in the June 20, 2007 amendment, there is no reason to

remove this rejection. Insofar as the claim has not been changed from the June 20, 2007 Office action, this rejection is maintained.

If it should be deemed that the amendment does narrow the claim, this rejection is still maintained. Dumesnil's first roller surface is fully capable of distributing liquid over a roller-type liquid applicator.

Claims 1-7, 10, 12-16, 18, 26, 27, 29, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dumesnil in view of Bedrossian and Keller.

Dumesnil discloses the invention except for the lid and the roller perforations. Bedrossian teaches a lid to cover a paint receptacle. It would have been obvious to cover the paint receptacle to keep contaminants from soiling paint in the tray or to preserve the freshness of the paint by keeping it from drying out. Keller teaches a roller cover of either open-cell foam or sponge material suitable materials capable of carrying paint (see paragraph [0029], lines 1-6). The foam and sponge materials are perforated. It would have been obvious to modify the roller to be covered by a perforated material roller cover so that the first roller surface becomes the outer perforated surface of the roller cover to (1) protect the roller, (2) increase absorption properties of the roller and (3) allow for easy replacement of the roller cover when the roller cover first surface becomes worn.

Re claims 16 and 18, Bedrossian further teaches a handle. It would have been obvious to add a handle for easy carrying by a convenient and comfortable grip. Official notice was taken that protrusions on the container body for reinforcing and attaching a bail handle are well known in the non-final Office action mailed July 31, 2007. The Official notice is now being treated as a prior art admission. It would have been obvious to add the protrusions to reinforce the body at

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the area of bail handle attachment to prevent a rip or prevent excessive wear from occurring at the handle attachment site.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dumesnil in view of Bedrossian and Keller as applied to claim 1 above, and further in view of Carling et al. (Carling).

The Dumesnil-Bedrossian-Keller combination discloses the invention except for the X shaped support structure where a first rib approaches a second rib proximate the center of the body. Carling teaches the X shaped support structure supporting a generally planar surface as shown in Fig. 3. It would have been obvious to use the X shaped pattern for the first roller surface to provide reinforcement.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 10, 12-16, 18, 21, 22, 26, 27, 29, 30, 32, 33, 36-38 and 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims

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(the drawings) of U.S. Patent No. D524501 to Prokop et al. (Prokop) in view of Bedrossian.

Prokop discloses the invention except for the lid. Bedrossian teaches a lid to cover a paint receptacle. It would have been obvious to cover the paint receptacle to keep contaminants from soiling paint in the tray or to preserve the freshness of the paint by keeping it from drying out.

Claims 1-7, 10, 12-16, 18, 21, 22, 26, 27, 29, 30, 32, 33, 36-38 and 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims (the drawings) of U.S. Patent No. D524003 to Prokop et al. (Prokop) in view of Bedrossian.

Prokop discloses the invention except for the lid. Bedrossian teaches a lid to cover a paint receptacle. It would have been obvious to cover the paint receptacle to keep contaminants from soiling paint in the tray or to preserve the freshness of the paint by keeping it from drying out.

Applicant's arguments filed November 30, 2007 have been fully considered but they are not persuasive.

Regarding the perforated roller surface, the rejections have been modified to address this limitation.

Re Hanssen, applicant states that the amendment doesn't narrow the claims rejected by Hanssen. The Hanssen rejection is maintained. Applicant doesn't argue the claim language submitted in the June 20, 2007 amendment.

Re Dumesnil, the roller and container are capable of distributing liquid over a roller-type liquid applicator.

Re Dumesnil in view of Bedrossian, the lid can be applied to the upper edge after hooks 30, 32 are removed to tightly seal the lid without interference. Also, the sealing plugs 50 of Bedrossian are effective in sealing the slots made for hooks 30, 32.



Re the non-statutory obviousness double patenting rejections and applicant's request for explicit legal support, MPEP section 804 Part II. B. 3. Design/Plant – Utility Situations states in the first paragraph that “In general, the same double patenting principles and criteria that are applied in utility – utility situations are applied to utility – plant or utility – design situations.”

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Stephen J. Castellano/ whose telephone number is 571-272-4535. The examiner can normally be reached on increased flexibility plan (IFP).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony D. Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen J. Castellano/  
Primary Examiner  
Art Unit 3781

sjc